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MAY 25 2007

OFFICE OF PETITIONS

In re Application of :
Mark D. Scott et al :
Application No. 09/323,765 : DECISION ON PETITION
Filed: June 1, 1999 :
Attorney Docket No. 259.005US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 28, 2006, to revive the above-identified application. In view of the statements made in the petition as to the erroneous holding of abandonment by the Office, the petition is also being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

The petitions are **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704. Any renewed petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment must also be filed within TWO (2) MONTHS from the mail date of this application. Extensions of time in this instance are not permitted. Note 37 CFR 1.181(f).

This application became abandoned as a result of petitioner's failure to file a proper appeal brief within the time period provided in 37 CFR 41.37(a)(1). As a proper appeal brief was not filed within one (1) month of the Notification of Non-Compliance with 37 CFR 41.37(c)(1), mailed April 26, 2006, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was

allowed, the application became abandoned on May 27, 2006. See MPEP 1215.04.

DISCUSSION OF PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE HOLDING OF ABANDONMENT

The petition states that the holding of abandonment was improper because "it was discovered that the erroneous citation of references by the Examiner was at least in part a cause of the failure for a proper response to have been made." The petition further states that "[e]ven though there were errors in the third Brief On Appeal submitted, with the Rules changing and the reasons for objection constantly changing by action of the PTO, the Brief was in condition for Appeal, even if less than perfect."

The petition fails to provide any showing where there was an error in the holding of abandonment in this application, either in the alleged erroneous citation of references or to the objections made by the Examiner to the Appeal Briefs. In fact, petitioner concedes that the Appeal Brief was less than perfect due to changes in the rules. Petitioner should note that he, as a registered practitioner, is charged with the knowledge of the applicable statutes, rules and regulations, and the failure to comply therewith is not a basis for withdrawing the holding of abandonment. It is noted that the Examiner, in the Notice of December 29, 2005, and again in the Notice of April 26, 2006, advised petitioner of the rule changes made in August 2004.

In view of the above, the holding of abandonment is proper and will not be withdrawn.

DISCUSSION OF PETITION UNDER 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(III)(C). The instant petition lacks items (1), (3) and (4) above.

As to item (1) above, the Appeal Brief submitted with the petition to revive is improper for the reasons set out in the attached Examiner's courtesy copy of a Notification of Non-Compliant Appeal Brief (37 CFR 41.37). Accordingly, an Appeal Brief, which corrects the defects noted in the accompanying Notification, must be submitted to revive this application.

As to item (3) above, the petition fails to include a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional."

Turning last to item (4), a terminal disclaimer (and fee) is required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order. The reason being that utility and plant applications issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. 154(b) (as a result of the Uruguay Round Agreements Act (URAA)). See 35 U.S.C. 154(b) (1999); see also 37 CFR 1.701. If such an application is abandoned (1) during appeal, (2) during interference, or (3) while under a secrecy order, the patentee of a patent issuing from such an application is eligible for patent term extension for the entire period of abandonment. The requirement for a terminal disclaimer for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public. Accordingly, since this application was filed on June 1, 1999, which is after June 8, 1995 but before May 29, 2000, a terminal disclaimer is required.

In sum, the petition to revive cannot be granted until such time as petitioner has complied with items (1), (3) and (4) above.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 P. O. Box 1450
 Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.


Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: Courtesy Copy of Notification of Non-Compliant
Appeal Brief (37 CFR 41.37)

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/323,765	Applicant(s) SCOTT ET AL.	
	Examiner Robert C. Hayes, Ph.D.	Art Unit 1649	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 28 August 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.

Continuation of 10. Other (including any explanation in support of the above items):

1) The "Summary of Claimed Subject Matter" on page 7, line 10, still states "and a method by which cells may be converted....". In contrast, the claimed invention is directed to only the product, "non-immunogenic cells"; thereby, confusing the issues on appeal (item 4 in defective brief Paper No: 20060425),

2) Page 8 of the brief for "Grounds of Rejection to be reviewed on Appeal", and page 9, line 12 still incorrectly states "1) Claims... have been rejected under 35 USC 102(e) as anticipated by Desai et al (U.S. Patent 5,578,442) in view [versus in light] of Lin et al [or Lin and Riggs... same reference]" (item 6 in defective brief Paper No: 20060425...). This is language for a rejection under 35 USC 103, not a rejection under 102; thereby, confusing the issues on appeal,

3) Arguments on page 11, lines 20,22 & 24, as well as page 12, line 19, etc. (also page 16, line 9 & page 19, line 21) still argue about "virus particles", which is not a topic for this application (item #6 in defective brief Paper No: 20060425); thereby, confusing the issues on appeal,

4) Arguments on page 16 of the brief (lines 1-2) correctly recite the 102(b) rejection, yet the discussion beginning on line 3 now states "claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desai et al., in view of Francis et al...", this is the next and third rejection, not the second ground of rejection; thereby, confusing what is being appealed and argued,

5) Although copies of the references are now submitted (except, of course, U.S. Patent 5,578,442), Desai (WO 93/18649) is included in the evidence section, yet no rejections using this reference are of record; thereby, now confusing what Desai reference is being used in the rejection under 35 USC 103(a), which previously was clearly '442. This one particular WO reference should not be mentioned, nor included in the evidence appendix section.

It is noted that Appellant is correct that the date for the Lin reference is 1974, and not 1976, as originally and correctly indicated on the 6/1/04 PTO-892. This is the sole reference by Lin et al made of record. Therefore, no confusion should be possible. Appropriate correction of this obvious typographical error in any subsequent communications by both Appellants and the Examiner should be made.